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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,613

05/29/2007

Marc Peuker

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EXAMINER

PAGAN, JENINE MARIE

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

05/28/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/598,613	Applicant(s) PEUKER ET AL.	
	Examiner JENINE M. PAGAN	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's Appeal Brief filed on 3/12/2010. Claims 1-25 are pending in the application. Claims 11-19 are withdrawn from consideration. Claim 26 is cancelled. The finality of the previous office action has been withdrawn. After careful consideration of the Applicant's remarks in the Appeal Brief filed, the Examiner believes a clarification of the rejection is necessary. The prosecution of the application is reopened.

The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitation "said sealing elements" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 8-9, 20-22 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz US 3,464,412.

Claims 1 and 25: Schwartz discloses a capsule body member 20 providing a main chamber 49, and comprising a dispensing opening 42, and wherein the inner wall of the capsule body member comprises a recessed area 24; an applicator member 30 being slideably accommodated in said capsule body member 20, said applicator member 30 providing an auxiliary chamber 45, and wherein said applicator member 30 comprises a through-hole 34 extending from the auxiliary chamber 45 to the outer circumferential surface of the applicator member 30; and an activator member 35 being slideably accommodated in said applicator member 30; said through-hole 34 and said recessed area 24 forming a channel between said main chamber 49 and said auxiliary chamber 45 upon activation of said capsule by said activator member 35; said main chamber 49 and said auxiliary chamber 45 being selectively connectable for fluid communication between said chambers upon activation of said capsule by said activator member 35 and is considered to be a kit. (Fig. 1)

Schwartz comprises the structures capable of performing the movement of said activator member 35 towards said dispensing opening 42 that is capable of causing movement of said applicator member 30 so that said channel between said main chamber 49 and said auxiliary chamber 45 is capable of being formed.

Claim 2: Schwartz discloses radially extending through-hole 34 in said applicator member 30 is initially covered by the wall of said capsule body member 20.

Claim 3: Schwartz discloses radially extending through-hole 34 is located in close proximity to the separation wall 33 of said applicator member 30 separating said auxiliary chamber 45 from said mixing chamber 49.

Claim 4: Schwartz discloses through-hole 34 extends essentially perpendicularly to the longitudinal axis of said applicator member 30.

Claim 5: Schwartz discloses through-hole extends essentially at an angle smaller than 90° to the longitudinal axis of said applicator member 30.

Claim 8: Schwartz discloses the applicator member comprises a sealing element 33 sealing said through-hole of said applicator member 30 against said recessed area of said body member and against the exterior of said capsule.

Claim 9: Schwartz discloses the activator member 35 comprising an activator sealing element 36 for sealing said activator member 35 against said applicator member 30.

Claim 20: Schwartz discloses a dispensing cannula 21 connected to said dispensing opening.

Claim 21: Schwartz discloses the dispensing cannula 21 is integrally formed with said capsule body member 20.

Claim 22: Schwartz discloses cannula 44 is rotatably connected to said capsule body member thus providing a valve. (Fig 3)

According to the Merriam-Webster Online Dictionary the definition of a needle as disclosed in Schwartz Fig 3, is “a slender pointed rod controlling a fine inlet or outlet (as in a valve)”.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the cannula rotatably connected to the capsule body as seen in figure 3 instead of integral as in figure 1, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlicnman*, 168 USPQ 177, 179.

Claim 23: Schwartz discloses the claimed invention as disclosed in claim 1 but it does not specifically disclose dental materials are glass ionomer cements or resin modified glass ionomer cements.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have dental materials be made of glass ionomer cements or resin modified glass ionomer cements, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 24: Schwartz discloses main chamber 49 contains a first, preferably powdery, component of said material, and said auxiliary chamber contains a second, preferably liquid, component of said material. (Col 4:48-59)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

However Dragan discloses (Fig 8) the raised area (see figure above) comprises an annular bulge.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the raised area included in annular bulge as taught by Dragan, since *Dragan* shows in Fig 8 that such a modification would allow the two substances an area to begin to mix together in a curvature manner.

Claim 10: Schwartz discloses the claimed invention as disclosed in claim 1 and 7 except a sealing elements are manufactured by a two-component injection molding process together with the capsule body member, the applicator member and said activator member.

In accordance to MPEP 2113, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Please note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product, i.e. sealing elements, does not depend on its method of production, i.e. two-component injection molding process. In re Thorpe, 227 USPQ 964, 966 (Federal Circuit 1985).

8. Claims 1-5, 8-9, 20-22 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz US 3,464,412 in view of Cohen US 2,754,590.

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Claims 1 and 25: Schwartz discloses a capsule body member 20 providing a main chamber 49, and comprising a dispensing opening 42, and wherein the inner wall of the capsule body member comprises a recessed area 24; an applicator member 30 being slideably accommodated in said capsule body member 20, said applicator member 30 providing an auxiliary chamber 45, and wherein said applicator member 30 comprises a through-hole 34 extending from the auxiliary chamber 45 to the outer circumferential surface of the applicator member 30; and an activator member 35 being slideably accommodated in said applicator member 30; said through-hole 34 and said recessed area 24 forming a channel between said main chamber 49 and said auxiliary chamber 45 upon activation of said capsule by said activator member 35; said main chamber 49 and said auxiliary chamber 45 being selectively connectable for fluid communication between said chambers upon activation of said capsule by said activator member 35 and is considered to be a kit. (Fig. 1)

Schwartz does not specifically disclose movement of said activator member towards said dispensing opening cause's movement of said applicator member so that said channel between said main chamber and said auxiliary chamber is formed.

However Cohen discloses movement of said activator member 26 towards said dispensing opening 22 causes movement of said applicator member 26.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the movement of the activator member towards the dispensing opening as taught by Cohen, since such a modification will provide an alternate method of moving the two members to mix the two chambers together.

Claim 2: Schwartz discloses radially extending through-hole 34 in said applicator member 30 is initially covered by the wall of said capsule body member 20.

Claim 3: Schwartz discloses radially extending through-hole 34 is located in close proximity to the separation wall 33 of said applicator member 30 separating said auxiliary chamber 45 from said mixing chamber 49.

Claim 4: Schwartz discloses through-hole 34 extends essentially perpendicularly to the longitudinal axis of said applicator member 30.

Claim 5: Schwartz discloses through-hole extends essentially at an angle smaller than 90° to the longitudinal axis of said applicator member 30.

Claim 8: Schwartz discloses the applicator member comprises a sealing element 33 sealing said through-hole of said applicator member 30 against said recessed area of said body member and against the exterior of said capsule.

Claim 9: Schwartz discloses the activator member 35 comprising an activator sealing element 36 for sealing said activator member 35 against said applicator member 30.

Claim 20: Schwartz discloses a dispensing cannula 21 connected to said dispensing opening.

Claim 21: Schwartz discloses the dispensing cannula 21 is integrally formed with said capsule body member 20.

Claim 22: Schwartz discloses cannula 44 is rotatably connected to said capsule body member thus providing a valve. (Fig 3)

According to the Merriam-Webster Online Dictionary the definition of a needle as disclosed in Schwartz Fig 3, is “a slender pointed rod controlling a fine inlet or outlet (as in a valve)”.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the cannula rotatably connected to the capsule body as seen in figure 3 instead of integral as in figure 1, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claim 23: Schwartz discloses the claimed invention as disclosed in claim 1 but it does not specifically disclose dental materials are glass ionomer cements or resin modified glass ionomer cements.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have dental materials be made of glass ionomer cements or resin modified glass ionomer cements, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 24: Schwartz discloses main chamber 49 contains a first, preferably powdery, component of said material, and said auxiliary chamber contains a second, preferably liquid, component of said material. (Col 4:48-59)

9. Claims 6-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz US 3,464,412 and Cohen US 2,754,590 and further in view of Dragon et al. US 5,172,807.

Claim 6: Schwartz/Cohen discloses the claimed invention as disclosed in claim 1 and 3 except the separation wall comprise a raised area extending towards said activator member.

However Dragan discloses a separation wall 138 comprise a raised area (see figure above) extending towards said activator member 266.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a raised area included in the separation wall as taught by Dragan, since Dragan shows in Fig 8 that such a modification would allow the two substances an area to begin to mix together.

Claim 7: Schwartz/Cohen discloses the claimed invention as disclosed in claim 1 and 3 except a raised area comprising an annular bulge.

However Dragan discloses (Fig 8) the raised area (see figure above) comprises an annular bulge.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the raised area included in annular

bulge as taught by Dragan, since *Dragan* shows in Fig 8 that such a modification would allow the two substances an area to begin to mix together in a curvature manner.

Claim 10: Schwartz/Cohen discloses the claimed invention as disclosed in claim 1 and 7 except a sealing elements are manufactured by a two-component injection molding process together with the capsule body member, the applicator member and said activator member.

In accordance to MPEP 2113, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Please note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product, i.e. sealing elements, does not depend on its method of production, i.e. two-component injection molding process. In re Thorpe, 227 USPQ 964, 966 (Federal Circuit 1985).

Response to Arguments

10. Applicant's arguments filed 3/12/2010 have been fully considered but they are not persuasive. In response to the Applicant's argument that Schwartz does not disclose activation of said capsule by said activator member, the reference of Schwartz discloses all of the structures that are claimed by the Applicant and the structures are capable of performing the functions intended by the user. There is activation of the capsule when the activator member 35 travel from the top of the chamber 45 as seen in

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figure 1 and travels down the chamber as seen in figure 2. In response to the Applicant's argument that Cohen does not cure the deficiencies of Schwartz, the reference of Cohen is referenced to later in the office action to show an alternate method of utilizing the members disclosed in Schwartz by having the members move toward the dispenser opening. In response to the Applicant's argument that the reference of Dragan does not disclose or suggest a separation wall having a raised area extending towards said activator member, it is shown in figure 8 of Dragan that moves toward the dispensing opening.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENINE M. PAGAN whose telephone number is (571)270-3216. The examiner can normally be reached on Monday - Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jenine M Pagan/
Examiner, Art Unit 3728

/Mickey Yu/
Supervisory Patent Examiner, Art Unit 3728